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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,363	03/17/2000	Mason Ng	40827.00039	4258
36614	7590	04/14/2005	EXAMINER	
MANATT PHELPS AND PHILLIPS ROBERT D. BECKER 1001 PAGE MILL ROAD, BUILDING 2 PALO ALTO, CA 94304			LIN, KENNY S	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/528,363	<b>Applicant(s)</b> NG ET AL.	
	<b>Examiner</b> Kenny Lin	<b>Art Unit</b> 2154	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Claims 1-8 are presented for examination.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/20/2005 has been entered. An action on the RCE follows.

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165.

5. Narasimhan was cited in the previous office action.

6. As per claims 3-4, Narasimhan taught the claimed invention including a method, comprising:

- a. Establishing a communication channel with a client computer system (col.1, lines 40-43, col.2, lines 50-65);
- b. Receiving information corresponding to new email events from the client computer system (col.4, lines 6-11, col.6, lines 11-21, 40-56); and
- c. Storing the information corresponding to the new email events in a database (col.4, lines 6-11, col.6, lines 11-21, 40-56).

7. As per claims 5-6, Narasimhan taught the claimed invention including a method comprising:

- a. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);
- b. Examining email data against the filter control data (col.5, lines 3-17);
- c. Determining at least one transfer protocol for the email data based on the examination (col.5, lines 42-49, col.6, lines 40-56, col.7, lines 39-45); and

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- d. Forwarding the email data according to the at least one transfer protocol via a computer network to a database (col.6, lines 19-21, 40-56).

### **Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (hereinafter Chen), US Patent 6,510,455, in view of Paarsmarkt et al (hereinafter Paarsmarkt), US Patent 6,118,856, and Narasimham et al (hereinafter Narasimhan), US 6,073,165.
10. Chen, Paarsmarkt and Narasimhan were cited in the previous office action.
11. As per claims 1-2, Chen taught the invention substantially as claimed including a method, comprising:
  - a. examining start criteria (col.6, lines 12-22);
  - b. determining whether the start criteria have been met (col.6, lines 12-22, 25-31);
  - and
  - c. obtaining new email events from an email database after the start criteria have been met (col.6, lines 25-52).

12. Chen did not specifically teach the method to forward information corresponding to the new email events via a computer network to a database. However, Paarsmarkt taught an email system to forward information or portion of information corresponding to the new email events via a computer network (col.2, lines 1-4, 15-17, 25-29, 48-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen and Paarsmarkt because Paarsmarkt's teaching of forwarding information or portion of information enables users to specify condition for forwarding received email to a remote device in Chen's email system. Chen and Paarsmarkt did not specifically teach that to forward information to a database. Narasimhan taught to store the information into database (col.4, lines 6-11, col.6, lines 11-21, 40-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen, Paarsmarkt and Narasimhan because Narasimhan's teaching of storing the forwarded information in a database enables subsequent recall of information from the database (col.6, lines 11-21).

13. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165, in view of Moon et al (hereinafter Moon), US Patent 6,138,146.

14. Moon was cited in the previous office action.

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15. As per claims 7-8, Narasimhan taught the invention substantially as claimed including a method, comprising:

- a. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);
- b. Examining email data against the filter control data (col.5, lines 3-17); and
- c. Determining based on the examination the email data that should not be forwarded (col.2, lines 3-6, col.5, lines 3-23);
- d. Generating receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18); and
- e. Forwarding the receipt data via a computer network to a database (col.4, lines 6-11, col.6, lines 11-21, 40-56).

16. Narasimhan did not specifically teach the step of generating receipt data identifying the email data that should not be forwarded. Instead, Narasimhan taught to generate receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18) and forward the receipt data via a computer network to a database (col.6, lines 19-21, 40-56). However, it would have been obvious that by identifying the email data that should be forwarded is equivalent to identify the email data that should not be forwarded. Moon taught to identify the email data that should not be forwarded and send the email data that should not be forwarded back to the server (col.2, lines 30-40, col.6, lines 16-20, col.7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon because Moon's teaching of identifying the

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email data that should not be forwarded enables Narasimhan's email system to be aware of which email messages to filter or block.

*Response to Arguments*

17. Applicant's arguments filed on 1/20/2005 with respect to claims 1-8 have been fully considered but they are not persuasive.

18. In the remark, applicant argued that: (1) As per claim 3-4, Narasimhan does not disclose receiving information corresponding to email events. (2) As per claims 5-6, Narasimhan did not disclose determining transfer protocols for the email data based on the examination. (3) As per claims 1-2, Paarsmarkt and Narasimhan do not disclosed forwarding email events. (4) As per claims 7-8, Narasimhan did not teach to forward any sort of receipt data to a database.

19. Examiner respectfully traverse the argument that:

These arguments were presented and traversed by the examiner in the Final Office Action mailed on 7/20/2004. No new arguments were raised.

As to points (1) and (3), Narasimhan taught to forward messages (col.6, lines 11-21; forwarding is known as a type of email event admitted by the applicant; see remark page 5). Paarsmarkt also taught to forward email (col.2, lines 1-4, 15-17, 25-29, 48-52). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the email events are events performed by a user such as created email, forwarded email, replied-to email, and trashed email") are not recited in



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the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to point (2), Narasimhan taught to examine email data against the filter control data (col.5, lines 3-17) and determining at least one transfer protocol for the email data based on the examination (col.5, lines 42-49, col.6, lines 40-56, col.7, lines 39-45). Column 5, lines 36-41 that preceded the cited area stated, "After creating the filter message (taught in col.5, lines 3-17), the source server encapsulates the filtered message and an associated address of the forwarding service in another computer message, addressed to a selected destination server. The source server may also include a receiver access code in the computer message, if needed." Column 5, line 42-49, Column 6, lines 40-56 and Column 7, lines 39-45 goes on to disclose that different protocols for data transfer may be used in accordance with the filtered results. Narasimhan further taught to use different protocols for data transfer (col.3, lines 10-20, 39-44) and suggested that many different communication protocols may be used (col.7, lines 42-45). In addition Narasimhan taught that the data transferring method can be determined (col.4, lines 42-47). As to point (4), This was addressed in the previous Non-Final office action. Narasimhan taught to send notice of receipt (col.3, lines 10-15, col.4, lines 6-11) to a database (col.6, lines 11-18).

### ***Conclusion***

20. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under

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37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl  
April 7, 2005

 **JOHN FOLLANSBEE**  
**SUPERVISORY PATENT EXAMINER**  
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